REMARKS

Claims 1-45 are pending in the application. Claims have been amended by this Amendment.

The Office Action dated August 23, 2004 rejected claims 1-25 as being directed to non-statutory subject matter under 35 USC 101; and rejected claims 1-31, 33, 35, 38, 40, 42 and 44 as being indefinite under 35 USC 112, second paragraph. The Office Action also rejected claims 1-25 based on U.S. Patent Publication No. 2002/0049622 to Lettich et al; rejected claims 26-31 based on U.S. Patent Publication No. 2001/0047284 to Blaylock et al; and rejected claims 32-45 based on a service provided by WebModal.

Statutory Subject Matter

The grounds for the rejection of claims 1-25 as being directed to non-statutory subject matter under 35 USC 101 is set forth in part 4 on pages 2-3 of the Office Action. Specifically, the rejection states that the modules recited in the body of independent claim 1 are understood to be software modules and that software per se is non-statutory subject matter. However, the original specification (see, for example, paragraphs 0028 and 0030) makes clear that a module of the logistics systems may or may not be a software only module and thus the modules recited in claim 1 are not necessarily limited to being software modules and may or may not include hardware. Applicants have amended claim 1 to affirmatively recite additional hardware elements of the logistics system and respectfully submit that the rejection has thus been overcome by the amendments.

Indefiniteness Rejection

The various grounds for the rejection of claims 1-31, 33, 35, 38, 40, 42 and 44 as being indefinite under 35 USC 112, second paragraph, are set forth in part 6 on pages 3-6 of the Office Action. Claim 1 was rejected as being indefinite due to the recitation of software modules and the absence of at least two physical hardware elements. This rejection has been rendered moot by the amendments made to claim 1 to overcome the statutory subject matter rejection. Claims 2 and 4 were rejected as being indefinite because it is not clear "what structural elements are responsible for performing the functionality..." Applicants

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respectfully traverse the rejection. So long as other requirements are met, it is permissible for a system or device to be defined in a claim by its functionality rather than its structure. See In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993). Claim 14 was rejected because the term "TSR" was unclear. Applicants have rendered the rejection moot by deleting the term from claim 14. Claims 33, 35, 38, 40, 42 and 44 were rejected because of incorrect dependencies. Appropriate amendments have been made to correct those dependencies.

There were a number of different comments included in the indefiniteness rejection of claims 26-31. First, claims 26-31 were rejected as being indefinite because of confusion over the recitation of various abstracts. Applicants have amended dependent claims 27 and 31 to eliminate any possible confusion. The amendments to claim 27 make it clear that the electronic abstract of the response received from the selected carrier is different than the electronic abstract of the contract. The amendments to claim 31 make it clear that the electronic abstract of the proposal is different than the electronic abstract of the contract. The rejection further states that claim 26 implies "that a final contract has been established between a shipper and selected carrier"; asks whether the recited contract is a finalized contract or merely a tentative bid, and states that it is unclear "when the final selection of a carrier is made and how many back-and-forth communications between the shipper and potential carriers are made before the final selection occurs." Keeping mind that claims are to be interpreted broadly, the stated implication of a finalized contract in claim 26 is improper. Furthermore, under the doctrine of claim differentiation, the confirming of the selected carrier recited in dependent claim 27 shows that this feature is not in claim 26 (or claim 31 not dependent on claim 27). It is not unclear for claim 27 to use the open-ended term "comprising" which requires that only the functions recited in claims 26 and 27 be performed, and does not require any number of back-and-forth communications between the shipper and potential carriers before final selection is made.

Applicants submit that all of the indefiniteness rejections have been rendered moot, traversed or satisfied by claim amendments and that all of the various rejections should be withdrawn. If any issues remain that prevent the withdrawal of these rejections, applicants respectfully request that the Examiner call and address the issues to avoid further delay in the prosecution of this application.

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Rejection of Claims 1-25 based on Lettich

The grounds for the rejection of claims 1, 2, 8, 10-13, 24 and 25 is set forth in part 8 on pages 7-9 of the Office Action. Specifically, the rejection relies upon an embodiment desired to be implemented on a website and described in paragraphs 0098 to 0310 of U.S. Patent Application Publication No. 2002/0049622 filed by Lettich et al (this embodiment hereinafter being referred to simply as "Lettich").[1] Claims 3-7, 9, and 14-23 are dependent on claim 1. The rejection grants a portion of Lettich priority back to the April 27, 2000 filing date of a provisional application. Applicants respectfully submit that the provisional patent application cannot be properly relied upon as a basis to reject the claims. (Although the rejection is hereinafter discussed using the numbered paragraphs of the published patent application, such reference is made merely for the sake of simplicity in having an easy point of reference.) Applicants also traverse the rejection because it does not establish a prima facie case that Lettich includes each and every one of the combination of features recited in the rejected claims.

The rejection states that paragraphs 161-175 of the published patent application are not expressly supported by the provisional patent application, but grants priority back to the filing date of the provisional application for the remaining disclosure. Before addressing this conclusion, applicants note that a comparison reveals that the provisional application did not contain Figs. 1 and 2, the Abstract, the claims, and at least a large part of paragraphs 23-35, 38, 40-46, 53-57, 64-68, 75-80, 82, 83, 88, 92, 97, 103-108, 110-113, 117-129, 142-147, 153-157, 162 and 311.

In order to rely upon the provisional patent application in the anticipation rejection based on 35 USC 102(e), the provisional application must not only describe the claimed invention, but the description must be an enabling disclosure of the claimed invention. In other words, the description itself must be sufficient to show one of ordinary skill in the art

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[1]   Applicants respectfully note that the Lettich reference was considered by the Examiner prior to appeal, and that the appeal was unilaterally terminated by the Examiner for "a new art rejection (i.e., a new combination of references)". There is no explanation of why the rejection could not have been earlier presented and applicants thus object to the termination of the appeal. Applicants respectfully request that they be provided with the opportunity and option to reinstate the appeal.

how to make the claimed invention without undue experimentation. See MPEP 2164.01. Thus, the common portions of Lettich which are in both the provisional patent application and the published patent application are not automatically granted priority back to the filing date of the provisional patent application. The common portions can only receive priority back to the filing date of the provisional patent application if they are an enabling disclosure.

The provisional patent application upon which this application is based provides numerous drawings (Figs. 1-11), work flows and accompanying text describing the architecture of a preferred embodiment of an integrated logistics system according to the claimed invention. This stark contrast to the provisional patent application of Lettich, which provides no such information for building its proposed system, is suggestive of a lack of enablement. See In re Epstein, 31 USPQ2d 1817, 1823 (Fed. Cir. 1994). The fact that Lettich added the technical details of paragraphs 165-171 and Figs. 1-2 when filing the published patent application one year later is also suggestive of enablement issue in the provisional patent application.

The Lettich provisional patent application describes at great length a dizzying array of various services, operations and products to be offered by an integrated "one stop" source of shipping and logistics information, products, services and operations on a website. One of ordinary skill in the art presented with the Lettich provisional patent application has no guidance whatsoever as to how to create this integrated "one stop" source on a website. While basic elements (i.e., computers, databases, software, etc.) are well known, the logistics system contemplated in Lettich is complex and there is no indication of any building blocks existing in the prior art that could be used to facilitate the system. Among the factors for determining enablement is the nature of the invention, the state of the prior art, and the amount of direction provided. See MPEP 2164.01(a). All of these factors dictate a conclusion that the Lettich provisional patent application is not enabling without undue experimentation.

Regardless of the above priority question, the Lettich rejection should be withdrawn because the provisional patent application being applied against the claims does not describe a logistics system having each and every one of the combination of features recited in independent claim 1. In particular, the Lettich application does not describe a logistics system

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having a modular architecture, much less that the system have the five specific modules recited in claim 1. The various paragraphs cited in the anticipation rejection deal with the services and products offered by Lettich. None of them address the architecture of the Lettich logistics system, much less describe these features. Regardless of whether these features would be enabled to one of ordinary skill in the art, they still must be affirmatively described in the reference in order for the Examiner to establish the necessary prima facie basis for a prior art rejection. In particular, even though the recited modules may be (but need not be) software only, and software may be organized as modules, the rejection based on Lettich should be withdrawn because Lettich does not describe these features.

Rejection of Claims 26-31 based on Blalock et al.

The grounds for the rejection of claims 26-28 and 31 is set forth in part 9 on pages 10-11 of the Office Action. Specifically, the rejection relies upon the an embodiment described in U.S. Patent Application Publication No. 2001/0047284 filed by Blalock et al (this embodiment hereinafter being referred to simply as "Blalock").[2] Claims 29 and 30 are dependent on claim 26. Applicants respectfully traverse the rejection because it does not establish a prima facie case that the published Blalock patent application includes each and every one of the combination of features recited in the rejected claims. Furthermore, applicants respectfully submit that the provisional patent application of Blalock is necessary to antedate this patent application and does not include the disclosure of the published patent application relied upon as a basis to reject the claims.

Independent claim 26 is directed to a method of arranging for the shipment of goods and recites "evaluating a proposal to select a carrier" from among a plurality of carriers and "creating an electronic abstract of a contract between the shipper and the selected carrier for the shipment of goods identified in the proposal." The rejection points to paragraphs 60-62 and 150 as disclosing these features of claim 26.

There is no party in Blalock that can perform the feature of evaluating a proposal to select a carrier. The cited and other paragraphs make clear that Blalock is an auction or

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[2]   A portion of the copy of Blalock provided to applicants is not legible, and therefore this Amendment is prepared based on the information available at this time. Applicants have separately requested a legible copy and reserve the right to provide a further response after receipt of a legible copy.

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bidding process on a website where a shipper provides a shipment proposal to the website and carriers submit bids on the proposal hoping that the shipper will select them to conduct the shipment. Although the shipment is maintained on the website and carriers are enabled to review and evaluate the shipment proposal, the carriers do not select the carrier among the plurality of carriers that will conduct the shipment. Conversely, although the shipper selects the carrier, the shipper does not evaluate the shipment proposal. There is no third party logistics provider or other party in Blalock that performs this feature.

No electronic abstract of a contract is created in Blalock. Paragraph 62 cited in the rejection reads as follows:

> "Finally, in the last step of the bidding and negotiation process, the carriers can view the awards that have been made and choose whether or not to accept them. Once accepted, the negotiation is complete. An electronic notification is sent to ABC Company, and appropriate written contracts may be executed."

There is no indication here that an electronic abstract of a contract is created. The electronic notification is of the fact that the carrier has accepted the reward. If the electronic item sent to the shipper was an electronic abstract of a contract, then it would not be referred to as a "notification". This is especially true since the very same paragraph also refers to written contracts.

With respect to the provisional patent application, applicants can find no mention that the shipment proposal includes "transaction information relating to the contract terms for the shipment". Applicants also cannot find any mention of an electronic notification, much less any mention of an electronic abstract of a contract. These features must be in the provisional patent application in order for this application to be predated by Blalock.

Claim 27

Claim 27 further recites that an electronic abstract of the response received from the selected carrier is created. In Blalock, the carriers respond directly on the auction website. There is no indication that an electronic abstract is created of the carrier's response. Indeed, it would appear unnecessary to do so in Blalock since the shipper has access the auction website.

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Claim 31

Claim 31 further recites that an electronic abstract of the shipper's proposal is sent to the potential carriers. In Blalock, there is no indication that there is an electronic abstract of the shipper's proposal, nor that it is sent to the potential carriers. Indeed, it is unnecessary to do so in Blalock, since the carriers can access the proposal on the auction website.

Rejection of Claims 32-45 based on WebModal

The grounds for the rejection of claims 32-34, 38 and 40 is set forth in part 10 on pages 11-12 of the Office Action. Specifically, the rejection asserts that the claims are anticipated under 35 USC 102(a) by the intermodal shipping service of WebModal launched in June 2000. All other rejected claims are dependent on independent claim 32. Applicants respectfully traverse the rejection on the basis that it fails to establish a prima facie case that the WebModal service included each and every one of the combination of features recited in the rejected claims.

For example, claim 32 recites "retrieving routing information for a plurality of different transport modes"; "determining a routing for the shipment of goods . . . based on said retrieved routing information"; and "scheduling . . . the shipment of goods." The rejection relies on two paragraphs in each of two documents referring to the WebModal service for each of these features.

There is no mention of routing information in either of the documents. The documents refer to information on "rates and schedules" and "prices and schedules" of multiple carriers. Furthermore, the WebModal service is described as allowing a user to "type in their transportation requirements online" and "immediately view a list of move choices, including carriers, prices and schedules for each offering, and order the move online." There is no indication that the WebModal service determines the routing for a shipment of goods. It could be that the user has to designate the origin and destination, and the service cannot process multi-hop shipments or allow the user to decide the routing used in multi-hop shipments. Finally, while a user can order the shipment of goods online using the service, there is no indication that the user can set the schedule for the move as required in claim 32.

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Official Notice

Official Notice has been taken in the rejections of claims 14, 21, and 23. Applicants respectfully request that documentation be provided so that applicants can judge the propriety of these rejections.

Please charge any fees due in connection with the filing of this Amendment, to Deposit Account No. 02-4270 (Dkt. No. 6065/1US) and please credit any overpayment or excess fees to such deposit account.

Respectfully submitted,

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